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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,478	02/12/2004	Nicola Funnell	1578.607	2295
44208	7590	11/16/2006	EXAMINER	
DOCKET CLERK PO BOX 12608 DALLAS, TX 75225			MANOHARAN, MUTHUSWAMY GANAPATHY	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/777,478

Applicant(s)

FUNNELL, NICOLA

Examiner

Muthuswamy G. Manoharan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed on 9/5/2006 have been fully considered but they are not persuasive.

Examiner respectfully disagrees with Applicant's assertion on Page 2 of the Remarks, "The Applicant respectfully traverses the Examiner's rejections of the claims under Sections 112, 102(e), and 103(a) for reasons ..... then the SIB 11 information for the cell 2 would be overwritten with that received in the SIB 12". The limitation of the claims ("the same system information block information element relating to a cell information list is included in both system information block of type 11 and system information block of type 12") is broad and includes the case wherein same system information block information relating to a cell information list is included in both system information block of type 11 and system information block of type 12 could mean exactly the same system information block information relating to a cell information list is included in both system information block of type 11 and system information block of type 12.

Examiner respectfully disagrees with Applicant's assertion on Page 3 of the Remarks," **The Examiner further stated that the Applicant asserted, in the earlier response, that the SIB 12 is the "preferred SIB" but does not indicate where in the reference that this assumption is taught.** Reference is made to the final paragraph on page 6 of the amendment dated 31 January 2006 (responsive to the Office action of 1 November 2005). This paragraph of the earlier response refers to Table 8.1.1 of the

cited reference and states **"If some of the optional IEs (information elements) are not included in the system information block 12, the UE shall read the corresponding IEs in system information block 11."** That is, it is the IE from the **SIB 12 that is used in preference to the one in SIB 11.** And, additionally, the Examiner further states that, since the SIB 11 contains information about the SIB 12 by way of the "SIB indicator", the SIB 11 has to be processed for the SIB 12 to know whether the SIB 12 is broadcast in the cell. And, the Examiner maintains that processing the SIB 12 implies that the SIB has been processed before. **The Applicant notes that the claims of the present application relate to an order of application of SIB 11 and SIB 12, while the Examiner, in contrast, refers to "processing".**

**The purpose of the SIB indicator is not to detail the order of application of two SIBs with the same information element.**

If an SIB 12 indicator is false, the UE knows that there will not be any SIB 12 broadcast and will then apply SIB 11 in a connected mode. If the SIB 12 indicator is true, a prior art UE shall wait for the SIB 12 before applying the SIB 11. The SIB 11 does not have to be "applied" for the SIB 12 to know whether the SIB 12 is broadcast in a cell according to the SIB indicator".

As mentioned above, the Applicant argues that, **"The Applicant notes that the claims of the present application relate to an order of application of SIB 11 and SIB 12, while the Examiner, in contrast, refers to "processing".** However, Applicant's previous argument (**"If some of the optional IEs (information elements) are not included in the system information block 12, the UE shall read the**

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**corresponding IEs in system information block 11." That is, it is the IE from the SIB 12 that is used in preference to the one in SIB 11.)** is related to processing and not related to order of application of SIB 11 and SIB 12. Therefore, Applicant's assumption that SIB 12 is used in preference to SIB 11 is not consistent with his latter argument that **"The Applicant notes that the claims of the present application relate to an order of application of SIB**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by 3GPP (TS 25.331 v3.16.0 (2003-9)) (hereinafter Reference (A)).**

Regarding claim 1, Reference (A) teaches a method for handling system information in a mobile telecommunications system, the system comprising a network of a plurality of cells and at least one user equipment device, the method comprising, in the user equipment device: receiving a system information block of type 11 ("system Information Block type 12" in Section 8.1.1.6.11) and a system information block of type 12 ("system Information Block type 12" in Section 8.1.1.6.12), the system information

block of type 11 relating to idle and connected mode (line 2 ,14, and 22 in Section 8.1.1.6.11) and the system information block of type 12 relating to connected mode (line 1 in Section 8.1.1.6.12); each of the system information blocks of type 11 and 12 relating to measurement information (lines 7-9, lines 24-28 and lines 31-32 in Section 8.1.1.6.11; lines 14-53 in Section 8.1.1.6.12) and including at least one system information block information element (lines 29-31 in Section 8.1.1.6.11) and associated system information ("measurement identity", line 20 in Section 8.1.1.6.11 );

for any system information block, information element relating to a cell information list, determining whether the same system information block information element is included both in the system information block of type 11 and the system information block of type 12 (lines 49-50 in Section 8.1.1.6.11); and

when the same system information block information element relating to a cell information list is included in both the system information block of type 11 and the system information block of type 12, applying the system information associated with the system information block information element in the system information block of type 11 before applying the system information associated with the system information block information element in the system information block of type 12 ( Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Regarding claim 2, Reference (A) teaches a method according to claim 1, wherein the system information block information element is selected from the following system information block information elements; an information element relating to an intra-frequency cell information list (Section 10.3.7.33), an information element relating

to an inter-frequency cell information list (Section 10.3.7.13) and an information element relating to an inter-Radio Access network (RAT) cell information list (Section 10.3.7.23).

Regarding claim 3, Reference (A) teaches a method according to claim 1 wherein the system information block information element is any of the following: "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

Regarding claim 4, Reference (A) teaches user equipment device for a mobile telecommunications system, the system comprising a network of a plurality of cells ("cells" on Page 56, line 6) and at least one user equipment device ("UE" on Page 56, line 8), the user equipment device being arranged to carry out the steps of claim 1.

Regarding claim 6, Reference (A) teaches a method for handling system information in a UMTS mobile telecommunications system, the system comprising a network of a plurality of cells and at least one user equipment device, the method comprising, in the user equipment device:

receiving a system information block of type 11 ("system Information Block type 12" in Section 8.1.1.6.11) and a system information block of type 12 ("system Information Block type 12" in Section 8.1.1.6.12), the system information block of type 11 relating to idle and connected mode (line 2, 14, and 22 in Section 8.1.1.6.11) and the system information block of type 12 relating to connected mode (line 1 in Section 8.1.1.6.12), each of the system information blocks relating to measurement information (lines 7-9, lines 24-28 and lines 31-32 in Section 8.1.1.6.11; lines 14-53 in Section 8.1.1.6.12) and including at least one system information block information element

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(lines 29-31 in Section 8.1.1.6.11) and associated system information ("measurement identity", line 20 in Section 8.1.1.6.11); for any system information block information element relating to a cell information list, determining whether the same system information block information element is included both in the system information block of type 11 and the system information block of type 12 (lines 49-50 in Section 8.1.1.6.11), and when the same system information block information element relating to a cell information list is included in both the system information block of type 11 and the system information block of type 12, applying the system information associated with the system information block information element in the system information block of type 11 before applying the system information associated with the system information block information element in the system information block of type 12 (Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Regarding claim 7, Reference (A) teaches a method for handling system information in a 3G UMTS mobile telecommunications system, the system comprising a network of a plurality of cells and at least one user equipment device, the method comprising, in the user equipment device: when System information Block (SIB) 11 and SIB 12 are received with information elements relating to any of "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-frequency cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12) then the system information associated with the system information block information element in SIB 11 is applied before the system information associated with 20 the corresponding system information



block information element in SIB 12 (Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over  
Reference (A) in view of Laitinen et al. (hereinafter Laitinen) (US 6765891).**


Regarding claim 5, Reference (A) teaches all the particulars of the claim 1, except a computer program product comprising program code means stored on a computer readable medium when the program is run on a computer. However, Laitinen teaches in analogous art, (Col. 4, lines 29-40) computer program product comprising program code means stored on a computer readable medium when the program is run on a computer. Therefore, it would be obvious to one of ordinary skill in the art at the time invention to implement the method using a computer program product comprising program code means stored on a computer readable medium when the program is run on a computer. This modification provides a method of implementation of Radio Resource Control protocol for the UE-UTRAN radio interface.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muthuswamy G. Manoharan whose telephone number is 571-272-5515. The examiner can normally be reached on 7:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER